

(10)

FILED
MAR 8 1943
CHARLES ELMORE CHAPLEY
GLENK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

No. 799

THE PHILADELPHIA INQUIRER COMPANY, *Petitioner,*

v.

CONWAY P. COE, Commissioner of Patents, *Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA, AND BRIEF IN SUP-
PORT THEREOF.**

CHARLES K. DAVIES, JR.,
FRANK E. SCRIVENER,
Attorneys for petitioner.



SUBJECT INDEX

	Page
Opinions Below	2
Jurisdiction	2
Federal Statutes Involved	2
Questions Presented	4
Reasons for Granting the Writ.....	4
Statement of the Case	5
Specification of Errors	7
Argument	8
I. Conflicting Judicial Interpretations of the Lan- guage of the Federal Statute	9
II. Importance of Issues Raised	12
III. Need for Authoritative Interpretation of the Stat- ute by This Court	13
Conclusion	14

TABLE OF CASES

American Steel Foundries v. Robertson, 269 U. S. 372	12, 13
American Tobacco Company v. Gordon, 56 App. D. C.	
81, 10 Fed. (2nd) 646	11
Appeal of B. F. Goodrich Co., 52 App. D. C. 261, 285	
Fed. 995	11
California Packing Corp. v. Price-Booker Mfg. Co., 52	
App. D. C. 259, 285 Fed. 993.....	11
California Packing Corp. v. Tillman & Bendel, Inc., 40	
Fed. (2nd) 108	10
Estate of Beckwith, 252 U. S. 538	13
G. & J. Tire Company v. GJG Motor Car Company, 39	
App. D. C. 508	11

	Page
Goodrich Rubber Company v. Hockmeyer, 40 Fed. (2nd) 99	10
Phoenix Paint & Varnish Co. v. John T. Lewis & Bros., 32 App. D. C. 285	11
Schneider Brewing Co. v. Century Distilling Co., 107 Fed. (2nd) 697	10
United Drug Co. v. Rectanus Co., 248 U. S. 90.....	13
Yale Electric Corp. v. Robertson, 26 Fed. (2nd) 972....	9

STATUTES AND RULE

U. S. C. A., Title 28, Section 347	2
U. S. C. A., Title 35, Section 63	2
U. S. C. A., Title 15, Section 85	3
U. S. Supreme Court Rule 38, Paragraph 5	4

IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

No. —.

THE PHILADELPHIA INQUIRER COMPANY, *Petitioner,*

v.

CONWAY P. COE, Commissioner of Patents, *Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA, AND BRIEF IN SUP-
PORT THEREOF.**

*To the Honorable, the Chief Justice, and the Associate Jus-
tices of the Supreme Court of the United States:*

The petitioner, appellant below, prays the issuance of a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia entered in the above-entitled cause on the eighth day of December, 1942 (R. 66), affirming the judgment of the District Court of the United States for the District of Columbia for respondent, appellee below.

OPINIONS BELOW.

The District Court of the United States for the District of Columbia rendered an opinion dismissing petitioner's complaint (R. 26 et seq.). The majority opinion of the United States Court of Appeals for the District of Columbia sustaining the judgment of the District Court appears at page 55 of the Record, and the dissenting opinion of Associate Justice Stephens at page 60 of the Record.

JURISDICTION.

The judgment of the United States Court of Appeals for the District of Columbia was entered on the eighth day of December, 1942 (R. 66).

The jurisdiction of this court is invoked under Section 239 of the Judicial Code, as amended by the Act of February 13, 1925, 28 U. S. C. A. section 347.

FEDERAL STATUTES INVOLVED.

R. S. 4915—35 U. S. C. A. 63:

“Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof as the facts in the case may appear. And such adjudication if it be in favor of the right of the applicant shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where

there is no opposing party a copy of the bill shall be served on the Commissioner; and all of the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however to the right of the parties to take further testimony. The testimony, and exhibits, or parts thereof of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit." (As amended March 2, 1927 c. 273 Sec. 11; 44 Stat. 1336—March 2, 1929, c. 488—Sec. 2(b), 45 Stat. 1476.)

Act of Congress 1905—Sec. 5, 15 U. S. C. A. 85:

"That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark—"

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or hereafter may be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided That said name, distinguishing mark, character, emblem, colors, flag or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant:

“Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: * * *.”

QUESTIONS PRESENTED.

The issues raised by this case are two in number, both having to do with the interpretation of the Act of Congress of February 20, 1905 (15 U. S. C. A. 85):

(1) What is the meaning of the term “merchandise of the same descriptive properties” as it is used in the proviso to section 5 of the Act of Congress of February 20, 1905 (now with amendments codified in 15 U. S. C. A. Sec. 85), the controlling statute on the right to registration of trade-marks?

(2) What factors properly must be considered in a determination of whether two articles of merchandise are or are not, within the meaning of the statute, “of the same descriptive properties”?

REASONS FOR GRANTING THE WRIT.

A writ of certiorari should be granted under paragraph 5 of Rule 38 of this court, for the following reasons:

(1) The United States Court of Appeals for the District of Columbia, which, within the purport of the first clause of paragraph 5 (b) of Rule 38 of this court, stands in the same position as a circuit court of appeals, has rendered a decision in the instant matter which is in conflict not only with the decisions of other circuit courts of appeals on the same matter, but which also conflicts with its own prior decisions on the same matter.

(2) A determination of the issues raised in the instant case involves, and depends entirely (R. 55—second paragraph of majority opinion) upon the construction of a statute of the United States, namely: section 5 of the Act of Congress of February 20, 1905 (op. cit.).

(3) The particular section of the Act of February 20, 1905 with which this case is concerned denies registration to two classes of trade-marks: (1) those “identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties”, and (2) those “which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers”. The all-important inquiry in each case involving identical or similar trade-marks is whether such marks are applied to “merchandise of the same descriptive properties”. There is urgent need of an authoritative judicial determination of the meaning of the phrase, “merchandise of the same descriptive properties” as it is used in the statute; and of judicial establishment of a test to be applied in order to determine whether, in a given case, two articles are merchandise of the same descriptive properties. The question has not been, but should be settled by this court.

(4) Since virtually every commodity produced and marketed in the United States is a present or potential subject for the application of a trade-mark, an authoritative interpretation by this court of the instantly involved portion of the Act of Congress regulating the registration of trade-marks is of extreme importance to American industry.

STATEMENT OF THE CASE.

Petitioner filed an application for registration of its trade-mark EVERYBODY'S WEEKLY for a WEEKLY NEWSPAPER SECTION in the United States Patent Office on May 10, 1937. (R. 7.) The application was pub-

lished December 28, 1937 (R. 10) and an opposition was filed by King Features Syndicate. (R. 12.) Testimony was taken by Opposer during the course of which a copy of a British magazine entitled EVERYBODY'S was introduced into evidence. (R. 52-53.) The British magazine was in use in the United States prior to Petitioner's first date of use.

Upon hearing in the Patent Office, the opposition was dismissed, but in view of the exhibit in the record, petitioner's application for registration was denied *ex parte*. (R. 12-13.) Petitioner then appealed to the Commissioner of Patents (R. 14) and the Commissioner affirmed the decision on the opposition holding that, even though the likelihood of confusion was slight, pursuant to the provisions of the Act of February 20, 1905, the two trade-marks are identical, and the publications on which such trade-marks appear are merchandise of the same descriptive properties. (R. 15.)

Petitioner then filed its complaint (R. 2) in the District Court of the United States for the District of Columbia.

At the trial in the District Court of the United States for the District of Columbia, petitioner introduced the testimony of two trade witnesses (R. 39-49) to the effect (1) that the two publications differed in content, format, manner of distribution, field of distribution and class of purchasers; and (2) that in the opinions of the witnesses there could be no possibility that concurrent use of the trade-marks on the two publications might cause prospective purchasers or the public to confuse one publication with the other. The trial court, however, (R. 26 et seq.) refused to consider the expert testimony, but concluded, upon the basis of a mere inspection of the two publications, that such publications are, within the purview of the applicable statute, "merchandise of the same descriptive properties," and that petitioner's trade-mark, therefore, should be denied registration.

Petitioner then appealed to the United States Court of Appeals for the District of Columbia (R. 35), which sus-

tained the result of and concurred in the reasoning of the opinion of the trial court. (R. 55-60.)

The dissenting opinion of Associate Justice Stephens of the United States Court of Appeals for the District of Columbia (R. 60-65) condemns the reasoning of the majority opinion to the effect that a determination whether two given items are, within the meaning of the statutory language, 'merchandise of the same descriptive properties,' properly may be made by mere sensory inspection of the items by the tribunal. It is the conclusion of the dissent that the trial court should have considered, and should have given greatest weight to the testimony of expert trade witnesses as to the likelihood of confusion between petitioner's newspaper section and the British magazine, on the theory that "likelihood of confusion and what the trade thinks with respect thereto is the critical consideration for determining whether or not the descriptive properties of items of merchandise are the same." (R. 65.)

SPECIFICATION OF ERRORS.

(1) The United States Court of Appeals for the District of Columbia erred in affirming the judgment of the District Court of the United States for the District of Columbia dismissing petitioner's complaint.

(2) The United States Court of Appeals for the District of Columbia erred in holding that the test of confusion, as established in the Act of February 20, 1905, is related to the similarity of trade-marks, and not to the determination of the descriptive properties of the merchandise to which such trade-marks are applied.

(3) The United States Court of Appeals for the District of Columbia erred in holding that a determination of whether two articles of merchandise are, within the meaning of the phrase as used in the applicable Federal statute, merchandise of the same descriptive properties, may properly be made by consideration only of the intrinsic proper-

ties of the articles as disclosed by inspection, without any consideration of extrinsic evidence adduced to show the absence of any possibility of confusion occurring by reason of the application of identical or similar trade-marks to such two articles of merchandise.

(4) The United States Court of Appeals for the District of Columbia erred in not holding that the definitive test to be applied in a judicial determination as to the identity of the descriptive properties of any two given articles of merchandise, for the purpose of deciding upon the registrability of a trade-mark under the Act of Congress of February 20, 1905, should be the test of likelihood of confusion.

ARGUMENT.

The registration of trade-marks in the United States Patent Office is controlled by section 5 of the Act of Congress of February 20, 1905, now with amendments codified in 15 U. S. C. A. 85.

The section, after certain provisions not pertinent to the issues raised herein, provides that two classes of trade-marks shall be denied registration, i. e.: identical trade-marks applied to merchandise of the same descriptive properties; and trade-marks so nearly similar that their concurrent use on merchandise of the same descriptive properties would be likely to cause confusion in the minds of purchasers.

In the instant case, petitioner has conceded, from the beginning, that its trade-mark, **EVERBODY'S WEEKLY**, is, in legal contemplation, identical with the trade-mark, **EVERYBODY'S**. The sole issue, then, is as to the Congressional intent in the use of the phrase, "merchandise of the same descriptive properties": what is the meaning of the phrase as used in the controlling statute; and how shall it be determined, in a given situation, whether two articles are "merchandise of the same descriptive properties"?

I. Conflicting Judicial Interpretations of the Language of the Federal Statute.

The proviso to section 5 of the Act of February 20, 1905, has been the subject of prolific litigation, both in infringement suits and in proceedings (like the instant case) under R. S. 4915 (35 U. S. C. A. 63) to compel the registration of trade-marks.

It is to be noted, of course, that ex parte proceedings under R. S. 4915 are normally filed only in the District of Columbia for the reason that service of process can be had only in the District of Columbia unless the Commissioner of Patents chooses to accept service in another jurisdiction. Therefore cases of this character are seldom decided by the United States Circuit Courts of Appeals.

However, the point at issue in the instant case, i.e.: the interpretation of the proviso of Sec. 5, of the Act of 1905, has been specifically ruled upon by the United States Court of Appeals for the Second Judicial Circuit in the case of *Yale Electric Corp. v. Robertson*, 26 Fed. (2nd) 972, 1928 wherein the Court, speaking through Judge Learned Hand, held:

“There remains the question of registration, the goods not being of the ‘same descriptive properties’ in the colloquial sense. It would plainly be a fatuity to decree the registration of a mark whose use another could at once prevent. The act cannot mean that, being drafted with an eye to the common law in such matters. *American Steel Foundries v. Robertson*, 269 U. S. 372, 381, 46 S. Ct. 160 (70 L. Ed. 317). While we own that it does some violence to the language, it seems to us that the phrase should be taken as no more than a recognition that there may be enough disparity in character between the goods of the first and second users *as to insure against confusion. That will indeed depend much upon trade conditions, but these are always the heart of the matter in this subject.* It is quite true that in *Rosenberg v. Elliott* (C. C. A.) 7 F. (2d) 962, the court felt bound to find that caps and suits had the same descriptive properties, quite independently of the

confusion which had arisen. We cannot say that that is the case here, for the fact that flash-lights and locks are made of metal does not appear to us to give them the same descriptive properties, *except as the trade has so classed them. But we regard what the trade thinks as the critical consideration, and we think the statute meant to make it the test, despite the language used.* (Italics supplied) (26 F. (2d) at 974)

The decision of the Circuit Court for the Second Circuit and the decision in the instant case by the United States Court of Appeals are in absolute conflict. (Record Page 56, paragraphs 4 through 7.)

Other decisions of the Circuit Courts interpreting the phrase, "Merchandise of the same descriptive properties," include:

- Ph. Schneider Brewing Co. v. Century Distilling Co.*,
107 Fed. (2nd) 697, 10th Circuit.
- California Packing Corp. v. Tillman & Bendel, Inc.*,
40 Fed. (2nd) 108.
- B. F. Goodrich Rubber Co. v. Hockmeyer*, 40 Fed.
(2nd) 99 .

In all of these decisions, the various United States Circuit Courts of Appeals have decided that the question of the similarity of the goods, or, in other words, the question of whether the goods are of the same descriptive properties, can be determined only by a consideration of the extrinsic characteristics of the goods. This reasoning the United States Court of Appeals for the District of Columbia alone denies.

It is further submitted that the decision of which Petitioner now seeks review, is contrary to the prior decisions of the same Court in similar matters.

The United States Court of Appeals for the District of Columbia previously has held in many cases that the question of likelihood of confusion in trade between two commodities sold under the same trade-mark is related not to

the similarity of the marks but to the identity of the goods in the minds of the trade and the public.

American Tobacco Co. v. Gordon, 56 App. D. C. 81, 10 Fed. (2nd) 646.

App. of B. F. Goodrich Co., 52 App. D. C. 261, 285 Fed. 995.

Phoenix Paint and Varnish Co. v. John T. Lewis & Bros., 32 App. D. C. 285.

G & J Tire Co. v. GJG Motor Car Co., 39 App. D. C. 508.

In all of these previous decisions by the United States Court of Appeals for the District of Columbia, the practice has been uniform in holding that the essential test of whether goods are of the same descriptive properties under the applicable section of the Act is:— Will the concurrent use of the mark on the goods cause confusion? If not, then the goods are *not* of the same descriptive properties.

The United States Court of Appeals for the District of Columbia in the instant case has departed from the practice laid down since 1913 by that Court and the Circuit Courts of Appeals of other circuits.

A comparative study of the cases cited above discloses that the courts have pursued two methods of applying the statutory language to particular instances: (1) the somewhat haphazard procedure of determining the identity or lack of identity of the descriptive properties of given articles of merchandise by subjecting such articles to examination by the tribunal; and (2) the more logical and orderly procedure of searching for, and attempting to establish, a "yard-stick" by which the statutory phraseology may be applied to any situation with which the court is confronted. An excellent example of the latter method is found in the opinion of the United States Court of Appeals for the District of Columbia in *California Packing Corporation v. Price-Booker Manufacturing Company* (52 App. D. C. 259 at page 261; 285 Federal 993 at page 995), which is quoted

with approval in the dissenting opinion of Mr. Justice Stephens in the instant case (R. 61).

Thus it will be seen that the United States Court of Appeals for the District of Columbia, in holding, in the instant case, that the trial court was justified in arbitrarily deciding, without recourse to the expert testimony as to the impossibility of confusion in trade, that the two publications here involved are, within the meaning of the Act of 1905, "merchandise of the same descriptive properties", is in conflict not only with the rulings of other circuit courts of appeals, but also is in direct conflict with its own prior decisions in the same matter.

II. Importance of Issues Raised.

The matter at issue is of importance to all trade-mark owners, and to all applicants for registration of their respective trade-marks in the United States Patent Office.

During the course of the prosecution of an application for registration of a trade-mark in the Patent Office, either through *inter partes* or *ex parte* proceedings, decisions are made on the question of the descriptive properties of allegedly similar items by administrative action of tribunals in the Patent Office, which tribunals are concededly versed in the matters brought before them, but which must make their decisions without benefit of trade testimony, for the reason that the Patent Office procedure makes no provision for the taking of such testimony.

The Federal Statutes give dissatisfied applicants the right under R. S. 4915, as interpreted by this Court in *American Steel Foundries v. Robertson* (269 U. S. 372), the right to have their cases adjudicated by a competent court having jurisdiction. Thus the ultimate right of every present and future applicant for registration of a trade-mark is affected by the question presented to this Court here.

III. Need for Authoritative Interpretation of the Statute by This Court.

The United States Court of Appeals for the District of Columbia in its majority opinion has stated (R. 55), "the construction of the applicable statutory provisions is the whole of this case. . . ."

This court has in the past granted writs of certiorari to review decisions involving section 5 of the Act of 1905, but with particular reference to other portions of the section than that in issue here. (*American Steel Foundries v. Robertson, supra*; *Estate of Beckwith*, 252 U. S. 538.) In the *American Steel Foundries* case the court interpreted the "geographical" proviso to section 5.

The case law which has evolved from the varying judicial interpretations and applications of the proviso to section 5 of the Act is in a state of confusion as a result of the attempts of the various tribunals to seek and establish some definitive formula which may be applied to all situations necessitating a determination of the similarity of descriptive properties of given items of merchandise.

This court has never construed that section of the statute which is here at issue.

The Federal Trade-Mark Act of February 20, 1905 is the sole legislative pronouncement upon the registrability of trade-marks. Prior to the enactment of that statute, the law regulating the registration and use of trade-marks was a part of and stemmed from the broader law of unfair competition, "the general purpose of which", this court said in *American Steel Foundries v. Robertson, supra*, quoting *United Drug Company v. Rectanus Company* (248 U. S. 90), "is to prevent one person from passing off his goods or his business as the goods or business of another". In the Act of 1905 Congress made express the historical principles of the substantive law of trade-marks. It is expedient that the true legislative intent expressed by and through that Act be clarified and established by a decision of this court.

CONCLUSION.

Petitioner therefore prays that a writ of certiorari may issue, and, upon a review, the judgments of the United States Court of Appeals for the District of Columbia and of the District Court of the United States for the District of Columbia may be reversed.

CHARLES K. DAVIES, JR.,
FRANK E. SCRIVENER,
Attorneys for petitioner.



I N D E X

	Page
Opinions Below.....	1
Jurisdiction.....	1
Questions Presented.....	2
Statute Involved.....	2
Statement.....	3
Argument.....	5
Conclusion.....	11

CITATIONS

Cases:

<i>American Steel Foundries v. Robertson</i> , 262 U. S. 209.....	4
<i>American Steel Foundries v. Robertson</i> , 269 U. S. 372.....	9
<i>Baldwin Co. v. Robertson</i> , 265 U. S. 168.....	4
<i>California Packing Corp. v. Price-Booker Mfg. Co.</i> , 285 Fed. 993.....	11
<i>California Packing Corp. v. Tillman & Bendel</i> , 40 F. (2d) 108.....	6, 7, 11
<i>Century Distilling Co. v. Continental Distilling Co.</i> , 106 F. (2d) 486, certiorari denied, 309 U. S. 662.....	9
<i>Cheek-Neal Coffee Co. v. Hal Dick Mfg. Co.</i> , 40 F. (2d) 106.....	5, 7
<i>Cross v. Williams Oil-O-Matic Heating Corp.</i> , 48 F. (2d) 659.....	6
<i>Drackett Co. v. Chamberlain Co.</i> , 81 F. (2d) 806, certiorari denied, 299 U. S. 503.....	4
<i>Forst Packing Co., Inc. v. C. W. Antrim & Sons</i> , 118 F. (2d) 576.....	9
<i>B. F. Goodrich Co. v. Hockmeyer</i> , 40 F. (2d) 99.....	6, 7, 11
<i>Hygienic Products Co. v. Coc</i> , 85 F. (2d) 264.....	4
<i>Mercedith Publishing Co. v. O. M. Scott & Sons Co.</i> , 88 F. (2d) 324.....	7
<i>Revere Sugar Refinery v. Salvato</i> , 48 F. (2d) 400.....	9
<i>Rosenberg v. Elliott</i> , 7 F. (2d) 962.....	7
<i>Ph. Schneider Brewing Co. v. Century Distilling Co.</i> , 107 F. (2d) 609.....	10
<i>Sharp v. Coc</i> , 125 F. (2d) 185, 189.....	9
<i>Tetley & Co., Inc. v. Bay State Fishing Co.</i> , 82 F. (2d) 290.....	9
<i>Tomlinson of High Point v. Coc</i> , 123 F. (2d) 65.....	4
<i>Yale Electric Corp. v. Robertson</i> , 26 F. (2d) 972.....	10

II

Statutes:

	Page
Revised Statutes, Section 4915, as amended (35 U. S. C. § 63) -----	4
Trade Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 724; 15 U. S. C. § 85):	
Section 5 -----	2, 4

Miscellaneous:

Nims, <i>Unfair Competition and Trade-Marks</i> (3d Ed. 1936)	
§ 229 (b), p. 621 -----	6

In the Supreme Court of the United States

OCTOBER TERM, 1942

No. 799

THE PHILADELPHIA INQUIRER COMPANY,
PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA*

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court (R. 26-34) dismissing petitioner's complaint is reported in 38 F. Supp. 427. The opinion of the United States Court of Appeals for the District of Columbia (R. 55-65) is not yet reported.

JURISDICTION .

The judgment of the United States Court of Appeals for the District of Columbia was entered December 8, 1942 (R. 66). The petition for a writ of certiorari was filed March 8, 1943. The

jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether, in the circumstances of this case, the Commissioner of Patents improperly refused to issue a certificate of registration for the trade-mark "EVERYBODY'S WEEKLY", used by petitioner as the title of the weekly magazine supplement contained in its Sunday newspaper edition, on the ground that an identical mark had concededly been in prior use by a British weekly magazine circulated in the United States.

STATUTE INVOLVED

Section 5 of the Trade Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 724; 15 U. S. C. § 85) provides in part:

no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark * * *

(b) * * * *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely

to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: * * *

STATEMENT

On May 22, 1937, petitioner filed an application in the United States Patent Office for the registration of the trade-mark "EVERYBODY'S WEEKLY" for a weekly newspaper section (R. 7). An opposition filed by King Features Syndicate, Inc., based upon its use of the mark or name "EVERYBODY'S PICTORIAL WEEKLY" (R. 12, 27), was dismissed by the Examiner of Interferences because the opposer failed to show that it had used that mark before petitioner's earliest use of its own mark (R. 12), and no appeal was taken from this decision (R. 15). However, during the hearing on the opposition before the Examiner, the opposer had introduced a copy of a British magazine bearing the mark or title "EVERYBODY'S WEEKLY" (R. 13), which was published prior to petitioner's adoption of the name and which enjoyed some circulation in this country.¹ The Examiner of Interferences found that the British magazine and petitioner's publication possessed the same descriptive properties and that because of the close resem-

¹ The front page of the British publication contains the title "EVERYBODY'S—The popular Weekly," and the inside pages have the heading "EVERYBODY'S WEEKLY" (R. 13, 52, 53).

blance of the marks there was some likelihood of confusion; he therefore refused registration of petitioner's mark (R. 13). This decision was affirmed by the Assistant Commissioner of Patents, who held that while the likelihood of confusion was slight, denial of registration was proper because the two marks were "identical" and were "appropriated to merchandise of the same descriptive properties" within the meaning of Section 5 of the Trade Mark Act of 1905 (R. 16; rehearing denied R. 23, 24).

Petitioner thereupon brought this suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes, as amended (35 U. S. C. § 63),² to direct the respondent, the Commissioner of Patents, to issue to petitioner a certificate of registration of its trade-mark, which the complaint alleged respondent had refused (R. 4). After a trial, the district court dismissed the complaint (R. 34), finding as facts that petitioner's mark was "iden-

² This section, authorizing proceedings in the Federal district courts to review a refusal by the United States Patent Office to issue a patent on application, has been held also to be applicable to refusal by the Patent Office of an application for trade-mark registration. *American Steel Foundries v. Robertson*, 262 U. S. 209; *Baldwin Co. v. Robertson*, 265 U. S. 168, 179-181; *Drackett Co. v. Chamberlain Co.*, 81 F. (2d) 866 (C. C. A. 3), certiorari denied, 299 U. S. 503; *Hygienic Products Co. v. Coe*, 85 F. (2d) 264, 266 (App. D. C.); *Tomlinson of High Point v. Coe*, 123 F. (2d) 65 (App. D. C.).

tical with the mark in prior use by the British magazine" and that the two publications in question were "merchandise of the same descriptive properties" under Section 5 of the Act (R. 25). The trial court held that the likelihood of confusion is not material where the marks are identical and are applied to merchandise of the same descriptive properties, and that whether the descriptive properties are the same is not necessarily controlled by the likelihood of confusion between the publications (R. 26-34). The court below affirmed the judgment of the district court (R. 55-60), one Justice dissenting (R. 60-65). The opinion of the majority agreed with the reasoning of the trial court, also holding that if it is patently clear that the goods possess the same descriptive properties, extrinsic evidence as to the likelihood of confusion is not necessarily determinative (R. 55-60).

ARGUMENT

The proviso of Section 5 (b) of the Trade Mark Act of 1905 (*supra*, pp. 2-3) clearly specifies two classes of cases in which registration is to be denied on account of "a registered or known trade-mark" owned and in use by another and appropriated to "*merchandise of the same descriptive properties*":³ (1) where the two trade-marks are

³ The italicized phrase is generally interpreted as synonymous with "goods of the same class" as the latter term is used in the initial sentence of Section 5 (*supra*, p. 2). *Cheek-Neal Coffee Co. v. Hal Dick Mfg. Co.*, 40 F. (2d)

“identical,” and (2) where the applicant’s trade-mark “so nearly resembles” the other “as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.”

Petitioner accepts this analysis (Pet. 5, 8) and concedes the identical nature of its mark and the British mark as well as the antecedent use of the British mark (Pet. 6, 8). Petitioner’s contention is simply that in determining whether identical marks apply to merchandise of the same descriptive properties, the definitive test should be the likelihood of confusion (Pet. 8); and that the courts below erred in refusing to consider the opinion testimony of two trade witnesses that the concurrent use of the marks on the two publications would not cause confusion among prospective purchasers. Both these grounds are clearly without merit.

1. Petitioner’s theory, that the likelihood of confusion should be the sole test of whether the merchandise is of the same descriptive properties, would render most of the words of the proviso meaningless, and, as the court below pointed out, in effect would rewrite the statute (R. 57).⁴ For if merchandise is not of the same class unless

106, 107 (C. C. P. A.); *Cross v. Williams Oil-O-Matic Heating Corp.*, 48 F. (2) 659, 660 (C. C. P. A.); Nims, *Unfair Competition and Trade-Marks* (3d ed. 1936) § 229 (b), p. 621.

⁴See also concurring opinions in *California Packing Corp. v. Tillman & Bendel*, 40 F. (2d) 108, 114 (C. C. P. A.), and *B. F. Goodrich Co. v. Hockmeyer*, 40 F. (2d) 99, 104 (C. C. P. A.).

likely to be confused when bearing similar marks, then the entire first clause relating to identical marks becomes surplusage, and the second clause concerning similar marks becomes partly tautological. The court below properly observed that petitioner's contention would have the proviso read simply that no mark shall be denied registration unless likely to cause confusion (R. 57). No case has upheld that construction,⁵ and aside from the decision below, there is authority to indicate the contrary. Cf. *Rosenberg v. Elliott*, 7 F. (2d) 962 (C. C. A. 3); *Cheek-Neal Coffee Co. v. Hal Dick Mfg. Co.*, 40 F. (2d) 106 (C. C. P. A.).

2. The trial court held that whether the publications were merchandise of the same descriptive properties is a question of fact, to be determined "on the whole of the relevant evidence," and that while the opinion testimony of petitioner's witnesses as to likelihood of confusion is pertinent to that issue, it alone would not justify disregarding the obvious fact that the merchandise itself is of the same class.⁶ The trial court made findings

⁵ *Dicta* of the Court of Customs and Patent Appeals, which might lend support to that view, occur in cases involving products dissimilar on their faces, e. g., coffee v. fruits, shoes v. clothing (*California Packing Corp. v. Tillman & Bendel*, 40 F. (2d) 108; *B. F. Goodrich Co. v. Hockmeyer*, 40 F. (2d) 99). Doubt is cast upon such *dicta* by the same court's remarks in the more recent case of *Meredith Publishing Co. v. O. M. Scott & Sons Co.*, 88 F. (2d) 324, 326, 328.

⁶ "If the merchandise of itself is obviously of the same class, that fact cannot properly be disregarded merely be-

of fact that petitioner's magazine section and the British magazine in question were publications printed in English, having quite similar contents, and that the merchandise in question was of the "same descriptive properties" (R. 25). These findings, which were affirmed by the court below⁷ are in accord with those made in the Patent Office,⁸

cause individual opinion testimony of witnesses tends to show the likelihood of confusion is non-existent. But of course where there is doubt whether the merchandise, intrinsically considered, is of the same class, resort may very properly be had to extrinsic evidence as to confusion, which may in any such given case be of controlling importance in view of the undoubted consideration that the primary purpose of the whole trade-mark law, as a part of the wider subject of unfair competition, is to prevent confusion of the public as to the origin of goods of competing vendors. *American Steel Foundries v. Robertson*, 269 U. S. 372, 380; 63 C. J. Trade-Marks, p. 474, s. 147; *Affiliated Products Inc. v. Crazy Water Co.* (C. C. P. A.) 104 F. (2d) 366, 367" (R. 31).

⁷ "In the present case it has been clear to the Examiner, to the Assistant Commissioner, to the District Court, and now to us, that a magazine supplement section of a Sunday newspaper belongs to the same class for the purpose of trade-mark registration as a stapled, tabloid, weekly news-magazine. Just as extrinsic evidence would be cumulative when it was already clear that goods were not related, so here when the goods are so closely related, any amount of testimony that there was no 'confusion' (of the source) in fact would not alter the conclusion that the goods are of the same descriptive properties" (R. 59).

⁸ In the Patent Office proceedings, the Examiner of Interferences (R. 12-13) and the Assistant Commissioner of Patents (R. 15-16, 23-24) also found that the merchandise was of the same descriptive properties, the latter adding that it could not seriously be argued otherwise (R. 16, 24).

upon which rests "the power and the duty" to determine the question of similarity "in each case in the exercise of an instructed judgment upon a consideration of all the pertinent facts." *American Steel Foundries v. Robertson*, 269 U. S. 372, 382.

Petitioner has failed to sustain its burden of showing by clear and convincing evidence that the decision of the Commissioner of Patents denying registration was erroneous. *Century Distilling Co. v. Continental Distilling Co.*, 106 F. (2d) 486 (C. C. A. 3), certiorari denied, 309 U. S. 662. And since the findings of the district court are supported by the evidence, their affirmance below was proper. Cf. *Sharp v. Coe*, 125 F. (2d) 185, 189 (App. D. C.) (patent registration).

The decision below that a weekly magazine supplement section of a newspaper and a weekly tabloid news-magazine are merchandise of the same descriptive properties finds support on an *a fortiori* basis in similar decisions by the Court of Customs and Patent Appeals regarding bacon and coffee (*Forst Packing Co., Inc. v. C. W. Antrim & Sons*, 118 F. (2d) 576), canned fish and tea (*Tetley & Co., Inc. v. Bay State Fishing Co.*, 82 F. (2d) 299), and sugar and canned meat (*Revere Sugar Refinery v. Salvato*, 48 F. (2d) 400).

3. The asserted conflict in decisions (Pet. 9-12) is unreal. The case most strongly urged by peti-

tioner as conflicting with the decision below is *Yale Electric Corp. v. Robertson*, 26 F. (2d) 972 (C. C. A. 2), in which the court, apparently assuming that the trade-marks were identical, considered whether flashlights and locks were "merchandise of the same descriptive properties." In the first sentence of a paragraph, the entire remainder of which petitioner sets forth (Pet. 9, 10), the court said:

There remains the question of registration, the goods not being of the "same descriptive properties" in the colloquial sense.

Thus the case was one where the articles were not of the same class, were not apparently similar, and therefore extrinsic evidence of confusion had to be considered, in view of the purpose of the trade-mark law to prevent confusion of the public as to the origin of goods. Both courts in the instant case recognized the propriety of considering extrinsic evidence in such circumstances. The trial court in the instant case conceded that evidence as to likelihood of confusion may "be of controlling importance" in such circumstances (R. 31), and the opinion below contains similar language (R. 59).⁹

⁹ The other cases relied on by petitioner to establish a conflict are similarly distinguishable, and are distinguishable for the further reason that in none were the trade-marks held to have been "identical". *Ph. Schneider Brewing Co. v. Century Distilling Co.*, 107 F. (2d) 699 (C. C. A. 10)

CONCLUSION

The decision of the court below is correct. No conflict exists with regard to the issue presented in the instant case and the question is not one of general importance. It is respectfully submitted that the petition for writ of certiorari should be denied.

CHARLES FAHY,
Solicitor General.

FRANCIS M. SHEA,
Assistant Attorney General.

DAVID L. KREEGER,
Special Assistant to the Attorney General.

VALENTINE BROOKES,
LEON FRECHTEL,
Attorneys.

APRIL 1943.

(hard liquors as opposed to beer; different marks containing only one common word); *California Packing Corp. v. Price-Booker Mfg. Co.*, 285 Fed. 993 (App. D. C.) (pickles and relishes as opposed to canned fruits and vegetables; marks "substantially the same"); *B. F. Goodrich Co. v. Hockmeyer*, 40 F. (2d) 99 (C. C. P. A.) (overshoes as opposed to clothing; marks "confusingly similar"). Remarks in the last cited case and in *California Packing Corp. v. Tillman & Bendel*, 40 F. (2d) 108, (C. C. P. A.) (tinned coffee as opposed to canned fruits and vegetables), to the effect that the likelihood of confusion is the test of similarity of class, are only *dicta*, for the cases involved apparently different products, requiring resort to extrinsic evidence in order to determine whether registration should be granted.